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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Maria KORDOWICZ et al.

Examiner: Charles L. Patterson, Jr.

Serial No.: 10/009,500

Group Art Unit: 1652

Filed: December 11, 2001

Title: HYALURONIDASE FROM THE HURUDINARIA MANILLENSIS,
ISOLATION, PURIFICATION AND RECOMBINANT METHOD OF
PRODUCTION

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement dated February 17, 2004, Applicants hereby elect with traverse Group I, Claims 1-9 and 16-20, "drawn to a protein of SEQ ID NO:1 ..."

All the claims in the application involve related subject matter, e.g., hyaluronidases which are highly related to each other. For example, the present invention relates to hyaluronidases having at least 80% homology. See, e.g., Specification, Page 6, Lines 14-20. Moreover, a sequence comparison between species disclosed in the specification show very high sequence identity, e.g., 94%. See, attachment.

A search would therefore comprise overlapping subject matter, and it would not be an undue burden on the examiner to carry out a search. "If search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct invention." (Emphasis added.)

M.P.E.P. 803. Accordingly, withdrawal of the restriction is respectfully requested.

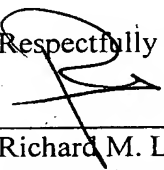
Moreover, it is improper to restrict between subject matter of a single claim. According to the M.P.E.P. 803.02 (Restriction - Markush Claims):

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

In this particular case, it is clear that unity of invention exists, and that therefore restriction is improper. The Patent Office can not refuse to examine subject matter that an applicant regards as his invention. A species election is more applicable.

No fee is believed to be due with this response, however, the Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,


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